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In the Supreme Court of the United States

WAL-MART STORES, INC., PETITIONER

v.

SAMARA BROTHERS, INC.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE SUPPORTING PETITIONER

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QUESTION PRESENTED

The Court limited its grant of review to the following question:

What must be shown to establish that a product's design is inherently distinctive for purposes of Lanham Act trade-dress protection?

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INTEREST OF THE UNITED STATES

A distinctive trade dress often serves essentially the same function as a trademark, giving consumers a ready means to associate one of a variety of competing goods with its source. Federal law accordingly protects a producer's trade dress, like its trademarks, under appropriate circumstances. The United States Patent and Trademark Office receives several hundred applications each year for the registration of marks based on allegedly protectable product designs, and the United States has a practical interest in ensuring that the legal standards for determining whether such designs are entitled to protection may be consistently and predictably applied. In addition, the United States has a strong policy interest in assuring that trademark pro-

tection is both properly extended and properly limited, so that it serves, rather than impedes, its goal of promoting consumer welfare through the enhancement of competition in the marketing of goods and services.

STATEMENT

1. Respondent Samara Brothers manufactures children's clothing, including a line of seersucker garments decorated with appliques of hearts, circus wagons, and the like. Pet. App. 2; see *id.* at 61-63 (photographs). In 1995, petitioner Wal-Mart Stores sent one of its suppliers pictures of a number of Samara's products and ordered the production of a quantity of essentially identical garments, which Wal-Mart then sold under its own label. *Id.* at 2. Samara sued Wal-Mart for, among other things, copyright infringement and infringement of the "trade dress" of its products. *Id.* at 3. A jury found that Wal-Mart had infringed Samara's copyrights and trade dress, and the district court awarded Samara $1.2 million in damages and more than $300,000 in costs and attorneys' fees. *Id.* at 3-4, 57-58.

Wal-Mart moved for judgment notwithstanding the verdict, arguing that the evidence did not support a conclusion that Samara's clothing designs could be legally protected as a distinctive trade dress. See Pet. App. 46. In rejecting that motion, the district court noted that a plaintiff's threshold burden is to "prove that its trade dress is protectable by showing * * * that it is either 'inherently distinctive' or has acquired distinctiveness through 'secondary meaning.'" *Id.* at 44. Applying Second Circuit precedent, the court explained that a product's design is "inherent[ly] distinctive[]" if it is "likely to be understood as an indicator of the product's source." *Id.* at 45 (quoting *Landscape Forms, Inc.* v. *Columbia Cascade Co.*, 113 F.3d 373, 378 (2d Cir. 1997), which in turn relied on *Knitwaves, Inc.* v. *Lollytogs, Ltd.*, 71 F.3d 996, 1008 (2d Cir. 1995)).

Although the court found "some merit" in Wal-Mart's argument that the "look" for which Samara sought protection "was so amorphous and used features so commonly found in children's clothing that it was not sufficiently distinctive to have identified Samara as being the source of the garments," ultimately it was "not persuaded that the jury's verdict should be set aside." Pet. App. 46. The court reasoned that the jury's finding of distinctiveness was supported by Samara's efforts over time to develop a "Samara look"; its advertising efforts; its sales success; Wal-Mart's efforts to "plagiarize the Samara look"; the jury's own review of "dozens of garments" produced by or for Samara, Wal-Mart, and others; and Samara's

> consistent use of seersucker, large appliques usually integrated into the construction of the garments, and garment designs, including scalloped collars, matching pockets, and the lack of excess ornamentation, to develop a clean, simple, uncluttered but elegant "look"—a look of "simple sophistication."

Id. at 47. The court acknowledged that "certain elements of Samara's designs were not protectable" by themselves, but it concluded that "the jury reasonably could have found that the combination of these elements was distinctive and thus protectable." *Id.* at 48.[1]

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[1] The court also held that, although Samara had failed to show any "actual confusion" among consumers with respect to the source of garments sold by Wal-Mart, it was nonetheless entitled to both injunctive and monetary relief, because the jury "reasonably could have found" both that Wal-Mart "deliberately sought to deceive consumers as to the source of its garments" and that it "failed to rebut the resulting presumption of consumer confusion." Pet. App. 49; see *id.* at 44, 49-53.

2. The court of appeals affirmed. Pet. App. 1-41. With respect to Samara's trade dress claim, the court first noted that "the purpose of trade dress law is 'to protect an owner of a dress in informing the public of the source of its products, without permitting the owner to exclude competition from functionally similar products." *Id.* at 7. It then observed that there was "no assertion in this case that Samara's seersucker garments have acquired 'secondary meaning' in the marketplace," so that Samara was entitled to protection only if the design of its children's clothing was "inherently distinctive." *Id.* at 8.

Like the district court, the court of appeals focused on the question it had articulated in *Landscape Forms* and *Knitwaves*: Whether the design claimed as a trade dress is "likely to be understood as an indicator of the product's source." Pet. App. 9. The court found this case "entirely distinguishable" from *Knitwaves*, which held that a design for children's sweaters was not protected because it "served an aesthetic, not a source-identifying, purpose." *Ibid.* In this case, the court explained, "Samara chose to design its line of spring/summer seersucker children's clothes using consistent design elements so that the look would be identified with Samara, building brand loyalty," and that product line represented "the core [of Samara's] business." *Id.* at 9-10.

The court found greater similarity between this case and *Landscape Forms*, which rejected trade dress protection for the design of a line of outdoor furniture. Pet. App. 10-12. The court noted, however, that *Landscape Forms* acknowledged the availability of protection for the "overall look" of a product, even though it held that the "look" claimed in that case was "too abstract to qualify as trade dress" because it failed to indicate what "unique combination of features" made the various

items in the product line "likely to be perceived by consumers as bearing the stamp of their maker." *Id.* at 11-12. In this case, the court reasoned, the evidence did "sufficiently depict[]" such a "distinctive combination of ingredients," including the "typical" use of:

> seersucker fabric; large bold appliques; large collars with the appliques generally integrated into the collar and any pockets on the garment; [a] general absence of printed images, black outlines, alphanumeric characters, three-dimensional features or heavy ornamentation (such as bibs or fringe) which are frequently used in children's clothing; and full-cut, one-piece conservative bodies.

Id. at 12-13. That level of specificity, in the court's view, "appear[ed] to meet the concerns raised by *Landscape Forms*." *Id.* at 13.

The court noted that "at times Samara's witnesses had difficulty constructing a coherent statement of the 'overall look' of [its] product line." Pet. App. 14. It concluded, however, that "as a whole, the record divulges * * * specific elements * * * which, when combined, create a distinctive overall look." *Ibid.* In any event, "[t]he jury was entitled to rely on th[e] testimonial evidence as well as its own analysis of the dozens of garments displayed at trial to conclude that Samara's product line is 'inherently distinctive'"; and, "viewing the evidence in a light most favorable to Samara," that evidence was sufficient to support the jury's verdict on the trade dress claim. *Id.* at 14-15.

Although it sustained the jury's verdict and the district court's judgment in the main, the court of appeals held that the injunction entered "fail[ed] adequately to describe Samara's trade dress," and thus "granted Samara far too much protection." Pet. App. 18. The

court held that to merit protection, any garment would have to include

> most if not all of the following elements: seersucker fabric used exclusively; two or three identically shaped and symmetrically placed cloth appliques (not screen printed) substantially similar to appliques displayed on Samara clothing in vibrant colors integrated into the collar (which is typically large and white), collar line and/or pocket(s) (if any); single-piece, full-cut bodies; and the absence of three-dimensional features, outlines and words.

Id. at 18-19. The court then noted that "not all of Samara's garments submitted into evidence at trial qualif[ied] for protection" under the court's formulation, because some "had so few of the described design elements that to afford them protection would mean awarding Samara a monopoly on all seersucker children's clothing with appliques placed anywhere on the garment." *Id.* at 19-20. Finding two such garments among the sixteen on the basis of which the jury awarded damages, the court directed that the damage award be reduced by the amount attributable to the one such garment that was not also covered by a Samara copyright. *Id.* at 21-22.[2]

Judge Newman dissented from the majority's disposition of the trade dress claim. Pet. App. 30-41. He emphasized, among other points, that federal trademark law must be construed "in the light of a strong federal policy in favor of vigorously competitive markets"; that courts should be particularly cautious in

[2] The court of appeals also sustained the district court's rulings with respect to matters not at issue here. Pet. App. 15-17, 21-29. The bulk of Samara's damages were awarded on the copyright claims. See *id.* at 22.

extending trademark protection to product designs (as opposed to, for example, packaging), and more especially to the design of an entire line of products; and that trade dress law does not protect "an idea, a concept, or a generalized type of appearance." *Id.* at 30-31. In Judge Newman's view, the elements identified by the majority were too common or general to constitute a protected "look," and in any event "many of the products in the alleged product line do not have all of even the few features that are claimed to constitute the 'look.'" *Id.* at 34; see *id.* at 32-34. He concluded that the majority had "unjustifiably lowered" the "high bar to trade dress protection for a product line," and that "[o]n the facts of this case, it was not reasonable [for the jury] to find distinctiveness." *Id.* at 31, 39.[3]

SUMMARY OF ARGUMENT

The protection of trademarks fosters competition by ensuring that marks serve to distinguish the goods of a particular producer from similar goods available in the marketplace. Trademark law protects, however, only a producer's interest in capturing the consumer goodwill associated with its reputation, as embodied by its distinctive, source-identifying mark. In other respects it allows free and open competition, including the imitation or even copying of products themselves.

Courts have classified potential trademarks along a spectrum that extends from "generic" to "fanciful." Generic marks are unprotectable; a "descriptive" mark is protectable only if the user can show that it has come to distinguish the user's goods from those of others in the marketplace; and "suggestive," "arbitrary," or "fanciful" marks are considered "inherently" distinc-

[3] Judge Newman would also have sustained challenges to five of Samara's copyrights. See Pet. App. 39-41.

tive, and are protectable without any such specific showing. Although the terminology used with verbal marks may not always be appropriate for cases involving packaging or product design, the spectrum principle is transferable to the trade dress context.

In *Seabrook Foods, Inc.* v. *Bar-Well Foods, Inc.*, 568 F.2d 1342 (C.C.P.A. 1977), the Court of Customs and Patent Appeals surveyed its trade dress cases and synthesized a set of focused, practical questions that are particularly relevant in determining whether a particular design should be recognized as "inherently" distinctive for purposes of trademark protection. Those questions include whether the claimed dress involves a common, basic shape or design; whether it is unique or unusual in a particular field; and whether it is merely a refinement of a commonly adopted or well known form of ornamentation for a particular class of goods. While particular circumstances may require additional or reformulated inquiries, experience indicates that *Seabrook* provides a concrete, relatively predictable, and therefore administrable approach to analyzing trade dress claims. That approach also has advantages over the "tests" articulated by some other courts.

The court of appeals erred in this case by upholding the jury's verdict on grounds of "inherent" distinctiveness without making an inquiry equivalent to that required under *Seabrook*.

ARGUMENT

A CLAIM THAT A PRODUCT'S DESIGN EMBODIES AN "INHERENTLY DISTINCTIVE" TRADE DRESS SHOULD BE EVALUATED USING THE PRACTICAL CONTEXTUAL INQUIRY SUGGESTED BY *SEABROOK FOODS* v. *BAR-WELL FOODS*

A. Trademark Law Protects Reputational Interests, But Allows Free Product-Based Competition

1. Trademarks serve to identify for consumers the source of goods available in the marketplace. See, *e.g.*, 15 U.S.C. 1127 (defining "trademark" by reference to the mark's ability and use "to identify and distinguish [a person's] goods * * * from those manufactured or sold by others and to indicate the source of the goods"). Such marks are effective in part because federal law prohibits the unauthorized use of a mark, or the use of any mark confusingly similar to one already in use. See generally 15 U.S.C. 1051 *et seq.*, 1114, 1125(a) (1994 & Supp. IV 1998) (the Lanham Act).

The legal monopoly on the use of a federally protected mark fosters competition in two ways. First, "by preventing others from copying a source-identifying mark, [trademark law] 'reduce[s] the customer's costs of shopping and making purchasing decisions,'" because use of the genuine mark then "quickly and easily assures a potential customer that *this* item—the item with this mark—is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past." *Qualitex Co.* v. *Jacobson Prods. Co.*, 514 U.S. 159, 163-164 (1995) (quoting 1 J. McCarthy, *Trademarks and Unfair Competition* § 2.01[2], at 2-3 (3d ed. 1994)). Second, protection of the mark "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product. The law

thereby 'encourage[s] the production of quality products,' and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer's inability quickly to evaluate the quality of an item offered for sale." 514 U.S. at 164 (again quoting McCarthy); see also, *e.g.*, *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (protection of trademarks "foster[s] competition and the maintenance of quality by securing to the producer the benefits of good reputation" (quoting *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)).

It bears emphasis that *trademark* law is not designed to encourage either innovation or creativity by according sellers any sort of monopoly on inventions or new designs. Those goals are pursued through the protection accorded, under strict conditions and for limited times, by patent and copyright law, on the theory that the conceded competitive costs of limited monopolies are substantially outweighed by the incentive effects of such monopolies in increasing the overall production of useful inventions and creative works. Trademark law does not involve any such weighing of opposing competitive effects. It secures to sellers all the *reputational* benefits (or detriments) of consumers' past experience with their products, while allowing free rein to any competitor who can produce the same product, or one close enough to satisfy consumers, at a lower price. In classic terms, what trademark law seeks to prohibit is the "passing off" of one producer's goods as those of another, well-reputed maker (thereby either appropriating or jeopardizing that maker's reputational goodwill).

2. Section 43(a) of the Lanham Act, 15 U.S.C. 1125(a), provides a cause of action against:

> Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which * * * is likely to cause confusion, or to cause mistake, or to deceive * * * as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.

As this Court has recognized, Section 43(a) protects not only trademarks per se, but also a product's "trade dress"—generally, its "total image and overall appearance." See *Two Pesos*, 505 U.S. at 764 n.1; Restatement (Third) of Unfair Competition § 16 (1993) (hereinafter Restatement) ("[t]he design of elements that constitute the appearance or image of goods or services as presented to prospective purchasers"). Moreover,

> [w]hile "trade dress" at one time "referred only to the manner in which a product was 'dressed up' to go to market with a label, package, display card, and similar packaging elements," the concept "has taken on a more expansive meaning and includes the design and appearance of the product as well as that of the container and all elements making up the total visual image by which the product is presented to customers."

Knitwaves, Inc. v. *Lollytogs, Ltd.*, 71 F.3d 996, 1005 (2d Cir. 1995) (quoting *Jeffrey Milstein, Inc.* v. *Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 31 (2d Cir. 1995)). Even using that "more expansive" definition, however, what

trademark law protects from copying is a product's distinctive, source-identifying "dress"—not the product itself.

To establish a claim for infringement of its trade dress, a seller must first establish that its dress is "distinctive"—either "inherently," or because it has acquired "secondary meaning" in the marketplace. See, *e.g.*, *Two Pesos*, 505 U.S. at 769.[4] That showing is a threshold requirement, because a dress that is not "distinctive" cannot possibly serve the source-identifying function that trademark law protects. In this case, the court of appeals indicated that there was no claim of "secondary meaning." Pet. App. 8. Its decision accordingly rested on a determination that certain common elements in the design of Samara's line of children's clothing are, taken together, "inherently distinctive"— or, at least, that the jury could permissibly so find. *Id.* at 8, 14-15.

In addition to distinctiveness, a plaintiff must show that the defendant's copying or imitation of the plaintiff's dress has given rise to a "likelihood of confusion" in the marketplace between the plaintiff's product and that of the defendant. *Two Pesos*, 505 U.S. at 769-770; see Pet. App. 8, 15-17. Moreover, the aspect of the plaintiff's dress that the defendant has copied must not be "functional"—that is, in general, it must not be "essential to the use or purpose of the [product] or * * * affect[] the cost or quality of the article," so that "exclusive use of the feature [for which protection is sought] would put competitors at a significant non-

[4] "'[S]econdary meaning' is acquired when 'in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.'" *Qualitex*, 514 U.S. at 163 (quoting *Inwood Labs., Inc.* v. *Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)).

reputation-related disadvantage." *Qualitex*, 514 U.S. at 165 (in part quoting *Inwood Labs., Inc.* v. *Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).[5] This Court's order granting certiorari limited review to the issue of what must be shown to establish, for these purposes, that a product's design is "inherently distinctive." 10/4/99 Order 1. Consideration of that question is informed by the existence of the confusion and functionality requirements, however, because those requirements underscore the purposes—and, correspondingly, the appropriate limits—of the Lanham Act's trade dress protections.

B. The Classification Of Potential Marks Along A Spectrum From Generic To Fanciful Is Applicable, In Principle, To Trade Dress Claims

1. As this Court has explained, for purposes of assessing their threshold protectability, trademarks "are often classified in categories of generally increasing distinctiveness." *Two Pesos*, 505 U.S. at 768. "[F]ollowing the classic formulation set out by Judge Friendly" in *Abercrombie & Fitch Co.* v. *Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976), many marks may be usefully ranked as "(1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos*, 505 U.S. at 768.

Using that scale, "generic" terms, which merely "refe[r] to the genus of which the particular product is a species," are not protectable at all. *Two Pesos*, 505 U.S. at 768. Generic terms do not normally identify a speci-

[5] If a trade dress is registered it is presumed valid, and functionality is an affirmative defense; if the dress is not registered, the plaintiff bears the burden of proving that it is "not functional." Pub. L. No. 106-43, § 5, 113 Stat. 220 (to be codified at 15 U.S.C. 1125(a)(3)); *Publications Int'l, Ltd.* v. *Landoll, Inc.*, 164 F.3d 337, 340 (7th Cir. 1998), cert. denied, 119 S. Ct. 1498 (1999).

fic producer, as distinct from the product they describe. Moreover, even if they did, granting a monopoly on use of the generic term would leave competing producers with no effective way to identify and market their goods to potential consumers, no matter how clearly the source or producer were identified. See *Abercrombie*, 537 F.2d at 9-10.

By contrast, marks that are "arbitary" or "fanciful" in relation to the product to which they are affixed, and those which are merely in some respect "suggestive" of the nature of the product, are considered "inherently" distinctive. *Two Pesos*, 505 U.S. at 768. The association between such a mark and the marked product is artificial; thus, the information the mark conveys to a consumer is likely to relate to the product's source, rather than its nature. Furthermore, because the supply of arbitrary, fanciful, and even "suggestive" marks is essentially unlimited, there is no reason for concern that protecting the appropriation of a given mark by only one producer will have any negative effect on the ability of competing producers to make and sell the same or similar products under different marks. *Abercrombie*, 537 F.2d at 10-11.

The final and most problematic category of marks is those traditionally classified as "descriptive." Because a descriptive mark bears a significant, non-arbitrary relationship to the marked goods themselves, a consumer might perceive the mark as conveying information about the nature of the goods, rather than about their producer. In that event, granting exclusive rights to the mark would tend to limit competition, without in fact advancing the goal of allowing the producer to protect and capture the value of its own reputation. On the other hand, under appropriate circumstances (such as after extended exclusive use by one producer) consumers *might* come to associate such a mark not only

with the sort of goods it "describes," but with a particular source or producer. Moreover, because the mark is not generic, protecting it under those circumstances would pose little threat to legitimate competition, because different producers would have other ways of effectively describing their versions of the same or similar goods. For these reasons, in the case of "descriptive" marks, trademark law strikes the balance between protecting reputational goodwill and preserving other means of competition by according protection to a mark only if its user can show that consumers have actually come to associate it with the source, rather than simply the nature, of the user's marked goods (*i.e.*, that the mark has acquired "secondary meaning"). See *Two Pesos*, 505 U.S. at 769; *Abercrombie*, 537 F.2d at 10.

2. In *Two Pesos*, this Court suggested its general approval of the use of the *Abercrombie* classification scheme in the trade dress context. *Two Pesos*, 505 U.S. at 768, 773. Thus, if a product's trade dress is "inherently distinctive," it is "capable of identifying products or services as coming from a specific source," and it is protectable under the Lanham Act without any showing of secondary meaning (although subject, of course, to the requirements of consumer confusion and non-functionality). *Id.* at 773. If the trade dress is not inherently distinctive, but is non-functional and not simply "generic," it is protectable, but only with a showing of secondary meaning. Cf. *Qualitex*, 514 U.S. at 162-163 (product's color not inherently distinctive, but protectable as trademark if it has acquired secondary meaning and is not functional).

Application of the *Abercrombie* classification to trade dress claims is not entirely unproblematic, however, because Judge Friendly was addressing marks made up of words, whereas trade dress typically involves non-

verbal characteristics such as "size, shape, color or color combinations, texture, graphics, or even particular sales techniques." *Two Pesos*, 505 U.S. at 764 n.1 (quoting *John H. Harland Co.* v. *Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)). In particular, while it is not difficult to understand how some non-functional elements of a product's design or "look" may be classified as "arbitrary" or "fanciful" within the ordinary meaning of those words, or how other such elements may be termed "generic," it can be perplexing to try to apply the terms "descriptive" and "suggestive" to non-verbal marks or to package or product designs. That perplexity may have serious consequences, because it is in differentiating among the three classifications at the lower end of the *Abercrombie* scale (from unprotectable "generic" marks to "inherently" protectable "suggestive" ones) that the law must focus most clearly on defining and implementing standards that will protect *both* genuine reputation-based competition *and* robust competition in the market for desirable goods, independent of their source.

For these purposes, it is not sensible to focus on particular terminology, rather than on concepts. The *principle* of the *Abercrombie* classification is that potential marks are distributed along a spectrum, from those that are essentially inseparable from the nature or concept of the goods being offered for sale to those that bear no inherent relationship to those goods whatsoever. In the middle is a variably problematic range in which a proposed mark bears some inherent relationship to the product, but is also sufficiently separable from the product so that it could be understood and treated primarily as a designator of source, while leaving competitors ample alternative ways of describing and marketing their own similar or identical goods. Whatever words are used to describe

that middle range, the concept is usefully transferable to the context of protecting trade dress under the Lanham Act.

C. The Practical Approach To Trade Dress Distinctiveness Claims Suggested By *Seabrook Foods* Serves The Goals Of Trademark Law In A Manner That Has Proven Effective And Administrable

The purpose of inquiring whether a particular trade dress is "inherently" distinctive is to determine whether it is necessary to demand proof of secondary meaning before according one seller the exclusive right to use that dress. The key question is therefore whether the design of one product "makes such an impression on consumers" that, "upon seeing a similar design on identical or closely related goods," they will "assume" that the the source of the first product is also the source of the second. *Seabrook Foods, Inc.* v. *Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977); see also *Qualitex*, 514 U.S. at 162-163 (inherently distinctive marks "almost *automatically* tell a customer that they refer to a brand").

Twenty years ago, the Court of Customs and Patent Appeals, considering the inherent distinctiveness of a packaging design, surveyed its cases and synthesized a set of basic, practical questions particularly relevant to that inquiry:

> In determining whether a design is arbitrary or distinctive this court has looked to [1] whether it was a "common" basic shape or design, [2] whether it was unique or unusual in a particular field, [and] [3] whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods.

Seabrook, 568 F.2d at 1344 (footnotes with citations omitted).[6] As one commentator has observed, at bottom these questions are

> merely different ways to ask whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume *without proof* that it will automatically be perceived by customers as an indicator of origin—a trademark. The issue is whether the trade dress is of such an unusual design that a buyer will *immediately* rely on it to differentiate the source of the product.

1 J. McCarthy, *Trademarks and Unfair Competition* § 8:13, at 8-36 to 8-37 (4th ed. 1999) (emphasis added, footnotes omitted). Thus, *Seabrook* asks straightforward, practical, design-oriented questions in an effort to focus the analysis on whether a plaintiff's claimed trade dress is so likely to serve the procompetitive goal of distinguishing the maker's goods from those of others that it merits trademark protection, even without any proof of secondary meaning.

Seabrook does not purport to exhaust the universe of questions that may be relevant in assessing whether a dress is "inherently" distinctive. Particular facts and circumstances may always require new, additional, or reformulated inquiries. The questions articulated in *Seabrook* itself have, however, proved not only useful but sufficient in guiding the distinctiveness inquiry in a broad range of cases. They accordingly provide, at a minimum, a solid starting place for analysis. Moreover,

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[6] Because *Seabrook* itself involved both visual designs and words, the court also noted a fourth question: Whether the design "was capable of creating a commercial impression distinct from the accompanying words." 568 F.2d at 1344.

the *Seabrook* questions have advantages not shared by, and avoid some pitfalls of, other "tests" suggested by some courts.

1. The specific questions asked in *Seabrook* apply as directly and with as much predictability in the context of product design as in other contexts. These factors provide a framework for the fact-finder's analysis of whether specific trade dress is inherently distinctive—that is, whether buyers will immediately rely on that dress to distinguish the goods of one producer from those of others.

If a design is a common or basic shape, it is generally reasonable to assume that consumers will not rely on it to distinguish goods or services of one producer from those of another. The use of common geometric designs in neckties, for example, would not likely be perceived by consumers as unique to a specific source, and accordingly it would not be "inherently distinctive." *Mulberry Thai Silks, Inc.* v. *K & K Neckwear, Inc.*, 897 F. Supp. 789, 796 (S.D.N.Y. 1995). Similarly, the shapes or designs common in a particular product field are highly relevant. The fact that all purse-sized make-up "compacts" use similar designs would, for instance, be fatal to a claim of inherent distinctiveness (or, perhaps, any distinctiveness at all). *Mana Prods., Inc.* v. *Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063, 1069-1070 (2d Cir. 1995). On the other hand, label designs for wine or liquor bottles are "selected from an almost limitless supply of patterns, colors and designs," and where there is no evidence of any "industry practice of using a design like the one that appears" on a particular maker's labels, that design is likely to be "inherently distinctive." *Paddington Corp.* v. *Attiki Importers & Distribs.*, 996 F.2d 577, 584 (2d Cir. 1993).

If a design is neither common nor strikingly unusual, it falls into the middle range of cases where it will often

be best to require proof of secondary meaning before deeming a design protectable. Although the final line is obviously difficult to draw, *Seabrook*'s third question—whether a claimed design is merely a refinement of a commonly adopted or well-known design, likely to be perceived by the public as mere dress or ornamentation—again usefully focuses the inquiry. For example, a T-shirt design featuring a cartoon of an animal with a flap forming the animal's mouth is not "inherently distinctive," because it is a mere refinement of common applique ornamentation on children's clothes. See *Jungle Rags, Inc.* v. *Rainbow Graphics*, 29 U.S.P.Q.2d 1704, 1708 (M.D. Fla. 1993). Similarly, a "troll" doll is not "inherently" distinctive when there are similar designs on the market, *EFS Marketing, Inc.* v. *Russ Berrie & Co.*, 76 F.3d 487, 491 (2d Cir. 1996); and a cobalt-blue liquor bottle is not "inherently" distinctive when many other liquor bottles use the same design characteristic. *Sazerac Co.* v. *Skyy Spirits, Inc.*, 37 U.S.P.Q.2d 1731, 1733 (E.D. La. 1995).[7]

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[7] Although the *Seabrook* questions will often be easily answered by reference to designs already in use in the marketplace, they are also useful in evaluating novel products, markets, or designs. It is possible to ask whether a design is "common," "unique," or something in between by reference to general experience, as well as by reference to a particular product or market. See *Turtle Wax, Inc.* v. *First Brands Corp.*, 781 F. Supp. 1314, 1321 (N.D. Ill. 1991) ("Presumably, it could be said about the trade dress of any new product that no competitive product combines precisely the same elements in its trade dress. * * * [T]hat fact alone does not make the product's trade dress inherently distinctive."). It may be that the law will often recognize new designs, or designs associated with new products, as inherently protect*able*. Appropriate limits on trademark protection, and protection of the interest in non-reputation-based competition, will then be supplied by the requirements that the design not be functional and that the plaintiff show consumer confusion.

Applying these principles to the present case, a factfinder would approach the issue of the inherent distinctiveness of Samara's claimed trade dress by asking three fairly specific and straightforward questions, well adapted to the context of product design: Is the design that comprises the claimed trade dress a common basic shape or design? Is it unique or unusual in the field of children's clothing? Is it merely a refinement of a commonly-adopted and well-known form of ornamentation for children's clothing? If, as seems likely, the answers to those questions would suggest that the claimed combination of design elements is not "inherently" distinctive as a form of trade dress, then Samara's use of that combination of elements would be protectable under trademark law only if Samara could show secondary meaning.[8]

By thus anchoring the analysis of "inherent" distinctiveness in a set of relatively concrete and easily applied questions, the *Seabrook* approach provides appropriate trademark protection for producers who have created distinctive, non-functional product designs that consumers are likely to perceive as identifying the source of goods, while preventing the exclusive appropriation of common or basic designs, or of mere variations on ordinary forms of ornamentation, without an actual demonstration that such a dress has acquired secondary meaning in the marketplace. Any approach that fails to provide such relatively definite, easily understood, and somewhat restrictive standards for the assessment of "inherent" distinctiveness risks extending trade dress protection to basic product de-

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[8] Samara would, of course, remain entitled to enforce its rights in the designs to which it holds valid copyrights. Copyright protection rests on the originality of the designs, not on their usefulness as a visual indicator to consumers of the source of goods.

signs that are not distinctive enough to strike the consumer immediately or automatically as unique identifiers of the *source* of a product, rather than simply as an aspect of the product itself. Extending trademark protection in those circumstances would improperly hinder product-related competition, without generating the benefits of reputation-related competition intended by the Lanham Act.[9]

2. Despite the considerable apparent variation in approaches adopted by the lower courts to the "inherent distinctiveness" question in trade dress cases, the basic *Seabrook* questions have been widely recognized as a useful analytic tool. The First Circuit, for example, recently reiterated its reliance on the *Seabrook* approach. *I.P. Lund Trading ApS* v. *Kohler Co.*, 163 F.3d 27, 40 (1st Cir. 1998). The Fourth Circuit, while adhering to the *Abercrombie* classifications, has recognized that *Seabrook*'s questions help give content to those classifications in product design cases. *Ashley Furniture Indus., Inc.* v. *SanGiacomo N.A. Ltd.*, 187 F.3d 363, 371 (4th Cir. 1999).[10] See also *Children's*

[9] Of course, even if a trade dress is deemed "inherently" distinctive, the Act does not protect exclusive use of that dress in the absence of a showing of consumer confusion, or if the design elements in question are "functional." See, *e.g.*, *Qualitex*, 514 U.S. at 165 (no protection if a product feature "is essential to the use or purpose of the article or if it affects the cost or quality of the article"); *Two Pesos*, 505 U.S. at 775.

[10] Although *Ashley* recognized that the *Abercrombie* spectrum "provide[s] the appropriate basic framework" in this context, it erred in stating that the question will usually be "whether an alleged trade dress can be considered arbitrary or fanciful or whether it must be ruled generic." 187 F.3d at 371. That way of framing the inquiry elides the middle of the *Abercrombie* spectrum, where a claimed dress (like a "descriptive" verbal mark) may be protectable, but only if the plaintiff can show secondary meaning. Given the complexity of the issue and the threat to

Factory, Inc. v. *Benee's Toys, Inc.*, 160 F.3d 489, 494 n.7 (8th Cir. 1998); *University of Florida* v. *KPB, Inc.*, 89 F.3d 773, 776 n.5 (11th Cir. 1996) (quoting *AmBrit, Inc.* v. *Kraft, Inc.*, 812 F.2d 1531, 1536 (11th Cir. 1986), cert. denied, 481 U.S. 1041 (1987). The *Seabrook* inquiry is also consistent with the discussion of "inherent" distinctiveness in the Third Restatement of the Law of Unfair Competition. Restatement § 16, cmt. b ("If the trade dress used by a particular seller differs in significant respects from that employed by others, consumers may be expected to utilize the trade dress as an indication of source."; where dress is "not sufficiently different from that used by others," trademark rights "will depend upon proof of distinctiveness through evidence of secondary meaning").

The Federal Circuit has cited *Seabrook* with approval, noting that "the focus of the [inherently distinctive] inquiry is whether or not the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive." *Tone Bros., Inc.* v. *Sysco Corp.*, 28 F.3d 1192, 1206 (Fed. Cir. 1994). Decisions of the Patent and Trademark Office's Trademark Trial and Appeal Board are directly reviewable by the Federal Circuit, see 15 U.S.C. 1071(a), and the PTO has thus continued to use the *Seabrook* approach, both in examining applications for trademark registration, see United States Department of Commerce, Patent and Trademark Office, *Trademark Manual of Examining Procedure* § 1202.04(b), at 1200-40 (2d ed., rev. 1.1, Apr. 1997), and in the administrative

legitimate competition posed by any over-extension of trademark protection, that intermediate result may be the most appropriate one in many product design cases.

adjudication of cases involving the "inherent" distinctiveness of designs for goods and services.

One trademark applicant, for example, sought to register packaging designed to resemble a gift-wrapped present as a unique "trade dress" for the applicant's Christmas-tree lights. *In re J. Kinderman & Sons, Inc.*, 46 U.S.P.Q.2d 1253 (T.T.A.B. 1998). Applying *Seabrook*, the examining attorney refused registration on the ground that there was "nothing unique or unusual about the designs," because designs resembling wrapped presents are common in the field of Christmas merchandise. *Id.* at 1254. Affirming that determination, the Trademark Trial and Appeals Board explained:

> while the designs * * * may be unique in the sense that we have no evidence that anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive. * * * [They] are a mere refinement of a form of ornamentation for Christmas merchandise. As such, purchasers and prospective customers for applicant's goods would be unlikely to regard these designs as identifying and distinguishing applicant's Christmas tree lights and indicating their source.

Id. at 1255. Similarly, in *In re File*, 48 U.S.P.Q.2d 1363, 1367 (T.T.A.B. 1998), the Board found that bowling alley patrons "would not be likely to regard applicant's tubular lighting scheme as identifying and distinguishing the source of such services." Rather, "the use by applicant of a novel or striking scheme of tubular lights * * * would be perceived by customers * * * as simply a refinement of the commonplace decorative or ornamental lighting arrangements to which they have become accustomed." See also, *e.g.*, *In re Hudson News*, 39 U.S.P.Q.2d 1915, 1925 (T.T.A.B. 1996) (blue

motif for a newsstand not inherently distinctive because it was "a mere refinement of a basic blue interior decorating scheme"). In the PTO's experience, *Seabrook* provides a concrete, relatively predictable, and therefore administrable approach to analyzing claims for trade dress protection.

3. The Second and Third Circuits have attempted to fashion special "tests" for use in evaluating claims that a product's design embodies an inherently distinctive trade dress. On examination, however, neither court's approach proves superior to *Seabrook*'s.

a. In *Duraco Products, Inc.* v. *Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1440 (3d Cir. 1994), the Third Circuit rejected use of Judge Friendly's *Abercrombie* categories in cases involving trade dress protection for a product's configuration, as distinguished from its packaging. The court correctly observed that classification of a verbal or symbolic trademark under *Abercrombie* is determined by the relationship between the mark and the product. *Id.* at 1440-1441. It reasoned that no such "dialectical" relationship exists between a product's design or configuration and the product itself. *Ibid.* The court then set out a new, three-pronged test, under which a "product configuration," comprising "a product feature or some particular combination or arrangement of product features," will be judged "inherently" distinctive only if it is "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product." *Id.* at 1449.

Although there is much to agree with in the court's thoughtful opinion, *Duraco* erred in concluding that the relationship between claimed trade dress in a product design and the product itself is not comparable to the relationship between a product and a verbal or symbolic mark. In order to be eligible for trade dress protection

at all, a design element (or combination of such elements) must be non-functional; but any design element that is not, in *Duraco*'s phrase, "conceptually separable" from the product itself would, by definition, be a "functional" aspect of the product. The second prong of the Third Circuit's test accordingly adds little to the "distinctiveness" inquiry; to the extent it makes a difference, it conflates the questions of distinctiveness and functionality.[11] As we have explained, in the "distinctiveness" context, non-functional design features generally may indeed be thought of as falling along a spectrum quite analogous to that defined by *Abercrombie*. See pp. 15-17, *supra*. The inquiry is therefore best advanced, not by rejecting *Abercrombie* as an organizing principle, but by seeking practical ways to locate where a particular design falls upon the spectrum from "generic" to "fanciful."

In that regard, the first prong of the *Duraco* test, which asks whether a design feature is "unusual and memorable," is sound in its basic thrust, but provides little concrete guidance to a factfinder. It seems more productive to proceed, as *Seabrook* does, by framing

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[11] In the design of some products, including much clothing, having consumers find the product attractive is one of the designer's central goals. In cases involving such products (such as *Duraco*, which involved ornamental garden planters, or this case), the issues of design distinctiveness and functionality will be closely related. They remain, however, separate questions. The fact that a design is sufficiently unusual, in the context of its product, to be "distinctive" does not answer the question whether it is so integrally related to the product's intended use, cost, or quality as to be "functional." On the other hand, the fact that a design is not sufficiently unusual in its context to be "inherently" distinctive does not dictate a finding that it is "functional." Such a design may still be entitled to protection, if the maker can show secondary meaning, and the court concludes that the design is sufficiently separable from the product to be "non-functional."

questions that, while general enough to be adaptable, are sufficiently specific to focus the inquiry on particular characteristics of the design that is claimed as a distinctive trade dress.

The third *Duraco* prong—whether the claimed dress is "likely to serve primarily as a designator of origin of the product"—again aims in the right direction, but it is at once too broad and too narrow. It accurately states the nature of the overall inquiry, but at too high a level of generality to be useful as part of a "test," rather than simply as a description of the underlying principle. At the same time, the word "primarily" seems to *narrow* unduly the range of designs that may be found "inherently" distinctive. From a Lanham Act perspective, the question is whether a claimed dress is sufficiently distinctive to be viewed as presumptively source-designating, without any showing of secondary meaning. So long as a design is source-designating (and non-functional), it is irrelevant whether it also serves some other purpose (such as to make the product more attractive to consumers), or whether one or another of those purposes could be characterized as "primary."

2. The Second Circuit, like the Third, has observed that *Abercrombie*'s trademark categories "make little sense when applied to product features." *Knitwaves*, 71 F.3d at 1008. Rather than adopt *Duraco*'s suggested test, however, the Second Circuit has "simply asked whether the design was likely to be understood as an indicator of the product's source." *Landscape Forms, Inc.* v. *Columbia Cascade Co.*, 113 F.3d 373, 378 (2d Cir. 1997); see Pet. App. 9. That question is essentially the third prong of the *Duraco* test—leaving out the term "primarily"—and it is, as noted above, unobjectionable as a statement of the general problem to be solved. Its shortcoming as a "test" is that it provides little help to the factfinder in making the necessary

determination on particular facts. That help must come in the form of more specific questions, such as those set out in *Seabrook*. Indeed, the Second Circuit has specifically indicated that it considers its approach to be consistent with *Seabrook*; that the *Seabrook* questions are "useful tools"; and that, "as suggested by *Seabrook*, objective considerations of the product and its similarity to others on the market will always be relevant and often [be] decisive." *Landscape Forms*, 113 F.3d at 378 n.3.

Both *Landscape Forms* and *Knitwaves* indicate that a producer's "subjective intention[]" that a design serve as source-identifying "may be probative" on the question of "inherent" distinctiveness. See *Landscape Forms*, 113 F.3d at 378 n.3; *Knitwaves*, 71 F.3d at 1009 (sweater designs not inherently distinctive because manufacturer's objective was "primarily aesthetic"). Whether a producer "intended" a product design to be source-identifying, aesthetically pleasing, or both (as will often be the case) should not, however, be relevant in determining whether a claimed trade dress is "inherently" distinctive. That determination turns on the likely perceptions of consumers, not producers: The question is whether the claimed trade dress "almost *automatically* tell[s] a customer that [it] refer[s] to a brand." *Qualitex*, 514 U.S. at 162-163. Whether the producer "intended" such an effect is not relevant; what matters is what consumers are objectively likely to perceive. Compare Pet. App. 9-10 (distinguishing *Knitwaves* on grounds of Samara's subjective intentions) with *Seabrook*, 568 F.2d at 1345 (rejecting similar contention: "[R]egardless of Seabrook's intentions, it is the association, by the *consumer*, of the 'oval' design with Seabrook as the source that is determinative."); see also Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. Rev.

461, 546 n.220 (1997) ("[T]he intention of the producer is unresponsive to the heart of the Lanham Act's distinctiveness inquiry, namely whether the mark *identifies* goods and *distinguishes* them from the goods of others. The Lanham Act requires examination of how a mark does behave, or is likely to behave, not of how the producer hopes it will behave.").

D. This Case Should Be Remanded For Reconsideration Using The *Seabrook* Approach

For these reasons, the approaches to the "inherent distinctiveness" inquiry adopted by the Third Circuit and the court below are either flawed in conception, or too general to provide factfinders with concrete guidance and therefore lead to predictable results. The preferable approach is, instead, to preserve and adapt the *Abercrombie* principle of a spectrum of possible relationships between mark and product, while framing specific questions, appropriate to the design context, to guide factfinders in determining whether a particular design falls sufficiently far along that spectrum to justify granting it protection without a showing that consumers *in fact* view it as designating a specific manufacturer or other source. *Seabrook* offers one tested starting point for such an analysis.

In upholding the jury's finding of distinctiveness in this case, the district court relied not only on the *Seabrook* factors or evidence that goes to the same issues (such as the garments themselves), but also on evidence of Samara's subjective intentions, which are irrelevant, and of other factors, such as advertising expenditures, that the court thought relevant only "because they [might] show secondary meaning." Pet. App. 47. The court of appeals, by contrast, sustained the verdict solely on grounds of "inherent" distinctiveness—although only after defining the Samara "look" to its

own satisfaction. *Id.* at 8-15; see *id.* at 17-21 (addressing proper scope of injunction). That court did not analyze the evidence in terms of whether the combination of design elements that constitutes Samara's claimed trade dress is common or basic, unique or unusual in the market for children's clothes, strikingly original or a mere refinment of a common form of ornamentation. In the absence of such an analysis, there was no sufficient basis on which to conclude, without proof of secondary meaning, that the claimed "look" of Samara's seersucker children's wear is so distinctive that it would "almost *automatically* tell a customer" that it represents a "brand." *Qualitex*, 514 U.S. at 162-163.

CONCLUSION

The judgment of the court of appeals should be reversed, and the case should be remanded for evaluation under a proper standard articulated by this Court.

Respectfully submitted.

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